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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,312	03/30/2001	Kenneth W. Aull	15-0227	8130

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Robert W. Keller
TRW Inc.
Law Dept.
One Space Park, Bldg. E2/6051
Redondo Beach, CA 90278

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

2

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,312

Applicant(s)

AULL, KENNETH W.

Examiner

Frantz Coby

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2171

This is in response to application filed on March 30, 2001 in which claims 1-10 are presented for examination.

Status of Claims

Claims 1-10 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-5, 7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman U.S. Patent no. 6,308,266 by.

As per claim 1, Freeman discloses "a method of arranging a plurality of digital certificates on a hardware token comprising: examining an extension of each certificate identification; recognizing whether each extension matches a specific extension; arranging said plurality of certificates so that a certificate having an extension which matches the selected extension is placed in a specific location in a list of said plurality of

Art Unit: 2171

certificates" by providing a system and method for enabling different grades of cryptography strength in a product (See Freeman Title, Abstract). In Freeman's system, a structure of a signed token is provided having an extension field that holds additional data and information as part of the certificate (See Table 1, Col. 8, lines 1-30) and in Table 2, Freeman provides the structure of the certificate including a signature extension that holds the token issued (See Freeman Table 2, Col. 2, lines 27-46).

As per claim 4, most of the limitations of this claim have been noted in the rejection of claim 1. In addition, Freeman discloses the claimed feature "wherein the hardware token is a smart card" (See Freeman Figure 5, component 42; Col. 8, lines 40-55; Col. 6, lines 13-19).

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 1. As to "a data storage area on said hardware token" (See Freeman Col. 6, lines 13-19); "a reader for examining an extension on a digital certificate" (See Freeman Col. 4, lines 61-64); a comparator for comparing said read extension with a selected extension; and an arranger for placing a certificate in a specific location on said token in accordance with the output of said comparator (See Freeman Figure 5 and corresponding text).

As per claim 7, Freeman discloses "a method of arranging a plurality of digital certificates on a hardware token, comprising: examining an extension of each certificate

Art Unit: 2171

identification; recognizing whether each extension matches a specific extension; arranging said plurality of certificates so that a certificate having an extension which matches the selected extension is placed in a specific location in a list of said plurality of certificates" by providing a system and method for enabling different grades of cryptography strength in a product (See Freeman Title, Abstract). In Freeman's system, a structure of a signed token is provided having an extension field that holds additional data and information as part of the certificate (See Table 1, Col. 8, lines 1-30) and in Table 2, Freeman provides the structure of the certificate including a signature extension that holds the token issued (See Freeman Table 2, Col. 2, lines 27-46).

As per claim 10, most of the limitations of this claim have been noted in the rejection of claim 7. In addition, Freeman discloses the claimed feature "wherein the hardware token is a smart card" (See Freeman Figure 5, component 42; Col. 8, lines 40-55; Col. 6, lines 13-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 6, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman U.S. Patent no. 6,308,266.

As per claims 2-3, 6 and 8-9, although Freeman discloses the structure of a token having extension of certificates as explained in the rejections of claims 1, 5 and 7; It is noted, however, Freeman did not specifically detail the claimed features of "wherein the specific location is first in said list"; "wherein the selected extension indicates a single sign-on certificate"; "wherein the digital certificate having an extension which matches the selected extension is placed first in the list of certificates" as recited in the instant claims 2-3, 6 and 8-9. However, one of ordinary skill in the art would have found it obvious to improve on the arrangement of the token structure and the certificate structure of Freeman by having the Extensions placed first in the list because that would have allowed Freeman to provide and improved technique for supplying cryptographically enhanced products more efficiently.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Maxi-Flex (Monday-Saturday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2171

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frantz Coby
Primary Examiner
Art Unit 2171

July 10, 2004